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IN THE

Supreme Court of the United States

October Term, 1949.

No. 19

TODD C. FAULKNER,

Petitioner,

v/s.

JOHN T. GIBBS,

Respondent.

BRIEF FOR JOHN T. GIBBS, RESPONDENT.

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No. 19

TODD C. FAULKNER,

Petitioner,

vs.

JOHN T. GIBBS,

Respondent.

BRIEF FOR JOHN T. GIBBS, RESPONDENT.

Opinions Delivered in the Courts Below.

Respondent John T. Gibbs brought suit in the United States District Court for the Southern District of California, Central Division, for infringement of claims 3 and 6 to 10 of his Patent No. 1,906,260 for a Game. The District Court did not write an opinion but, after discussion with counsel, at the close of the trial rendered its decision for the plaintiff, Respondent Gibbs, holding his patent as to the claims in suit valid and infringed by one form of a game constructed and operated by the defendant, Petitioner Faulkner, and claims 3, 9 and 10 infringed by a second form of the defendant's game.

Findings of Fact and Conclusions of Law were made by the District Court at R. 33-40 and an Interlocutory Judgment entered at R. 41-43.

On appeal to the Court of Appeals for the Ninth Circuit that court affirmed, 170 F. 2d 34, 79 U. S. P. Q. 158 [R. 538]. A petition for rehearing was denied November 23, 1948 [R. 548].

For an earlier concurring opinion on the same patent see *Gibbs et al. v. T. Z. R. Amusement Corporation et al.*, District Court, Eastern District of New York, 14 F. Supp. 957.

Jurisdiction of This Court.

The case is in this Court on certiorari granted March 28, 1949, 336 U. S. 935, 93 L. Ed. Adv. Op. 645.

As there was no conflict of decisions between Circuits, and Petitioner's Petition for Writ of Certiorari was granted without an opinion, we have no knowledge of the particular grounds upon which this Court accepted jurisdiction.

Statement of the Case.

We do not find it feasible to correct inaccuracies or omissions in the statement of the case contained in Petitioner's brief, and for that reason and to preserve a continuity we present the following statement:

THE GIBBS PATENT.

The Gibbs patent in suit, No. 1,906,260, applied for February 16, 1931, on a Game, issued May 2, 1933 [offered R: 55, copy in Book of Exhibits 295]. There are ten claims in the patent, all directed to a "game apparatus." Claims 3 and 6 to 10, inclusive, are involved in this suit.

The Gibbs game unit comprises a game board with holes corresponding to electric lights on an annunciator panel. A single ball is provided for the player to throw or roll

over the board and which, when dropping through a hole, will actuate an electric switch, dropping past it and returning each time to the player for a successive roll. Electrical circuits are provided whereby one of the electric lamps is energized when the corresponding switch is closed. The apparatus includes means such as a relay to maintain the circuit closed. This function can also be performed by an overbalanced switch or a switch of a releasable spring clamp type. The circuits are grouped so that when a line of lights, horizontal, vertical or diagonal, is energized a win circuit is established, a signal of some sort results, and the winner or winners of a plurality of these game units, which are electrically interconnected, remain lighted after the non-winners are de-energized.

This essence of the invention is clearly defined in the claims when read in the light of the description and drawings. The claims in suit are here copied.

"3. A game apparatus comprising a board having a plurality of contact devices thereon adapted to be engaged by an object moved over the board by a player, a plurality of indicators, means for electrically connecting said indicators with a source of electric current and with said contact devices, said indicators and said contact devices corresponding in number and arrangement and subdivided into corresponding groups, means for energizing said indicators as the associated contact devices are operated, an electrical circuit common to all of said groups and open until all of the indicators in one of said groups have been energized, and supplementary means for indicating a winning play when all of the indicators in one of said groups have been energized."

"6. A game apparatus comprising a plurality of units electrically connected together, each of said units

including a plurality of contact devices and a plurality of indicators corresponding in number and subdivided into corresponding groups, means for electrically connecting the contact devices with the corresponding indicators, means for electrically connecting said units together and with a source of electric current, said indicators adapted to be operated when and as objects are moved by the players into engagement with the contact devices, and means whereby when all of the indicators in any group of any one of said units have been operated to complete a winning play, the indicators on all of the units except the winning unit will be deenergized, while the indicators at the winning unit will remain energized, for the purpose described."

"7. A game apparatus as characterized in claim 6, including an independent supplementary signal at each of said units for signaling a winning play to the players."

"8. A game apparatus as characterized in claim 6, including an independent supplementary signal at each of said units for signaling a winning play to the players, and means under the control of an operator for opening and closing the circuits of all of said units simultaneously at will."

"9. A game apparatus comprising a plurality of electrically connected units, each including a game board with a plurality of apertures therein, and an annunciator with a plurality of indicators thereon, electrical contacts adjacent each of said apertures connected in the circuits of said indicators, said indicators and said apertures corresponding in number and subdivided into corresponding groups, whereby when objects are deposited in said apertures by the players at the several units corresponding indicators will be energized, a supplementary signal circuit on each of said units, and means for holding said signal

circuit open until all of the indicators of any group on each of said units have been energized, and for closing said signal circuit when all of the indicators of any unit have been energized, and means controlled by the closing of the signal circuit of the winning unit for discontinuing the signals and opening the circuits of the indicators on all other units."

"10. A game apparatus as characterized in claim 9, including an audible signal commonly connected with all of said units and adapted to be operated upon the closing of the supplementary signal circuit of any of said units."

GENERAL CHRONOLOGY.

Gibbs, the owner of the patent, Respondent here, commercialized his game by its introduction and operation in amusement parks during and subsequent to the year 1930, most installations being identified by the name "Fascination" [R. 67].

In the early 1930's, when he was operating his patented game in Coney Island, the game was copied there by the T. Z. R. Amusement Corporation. Gibbs brought suit for infringement in the Eastern District of New York. His patent as to all the claims thereof was held valid and infringed by District Judge Byers, in *Gibbs et al. v. T. Z. R. Amusement Corporation et al., supra*. Judge Byers made Findings of Fact and Conclusions of Law in addition to the reported opinion, said Findings and Conclusions being in evidence here [R. 60], text found in Book of Exhibits, page 344.

We call attention to one of the findings, Book of Exhibits, page 351, as follows:

"Seventeenth: That for the successful operation of the game of the Letters Patent in suit there are

certain structural and functional requirements which are fulfilled by the devices set forth in the claims 1 to 10 of said Letters Patent in suit, which are not disclosed or suggested in any of the games of the prior art, and which do not teach the construction, method of operation or results obtained and do not fulfill the requirements of the structures set forth in any of the claims 1 to 10 of the Letters Patent in suit."

The reported opinion shows that Judge Byers fully considered a number of prior art patents including, among others, Nakashima No. 1,678,573 [R. 376], Esmarian No. 1,612,912 [R. 393], and Irsch No. 1,433,888.

Nakashima was a reference in the file wrapper of the Gibbs patent and was selected by Petitioner's expert witness in the present case as one of the closest references. [R. 214]. The Esmarian patent is also one of Petitioner's prior art patents in the present case. The Irsch patent considered by Judge Byers was not put in evidence in the present litigation, but it finds its counterpart in the Irsch Patent No. 1,458,884 cited in the present case to show a cut-off principle when a win is made.

Gibbs brought other infringement suits on the same patent in three different jurisdictions which resulted in Consent Judgments in his favor as follows:

Gibbs et al. v. Surfeo Amusement Corp. et al.,
No. E-8577, Eastern District of New York, Consent Judgment October 28, 1938;

Gibbs v. Scientific Machine Corporation, Civil No. 2175, Eastern District of New York, Consent Judgment January 24, 1942;

Gibbs et al. v. Stanley Gersh, Civil No. 5728, Eastern District of New York, Consent Judgment August 29, 1945;

Gibbs v. Vincent Anderson, Civil No. 1556, District of Connecticut, Consent Judgment April 25, 1946;

Gibbs v. Levy, Eastern District of New York. (Date of Consent Judgment does not appear in the record here.)

The foregoing Consent Judgments were established by testimony of Respondent on stipulation of opposing counsel that copies of the Consent Judgments need not be produced [R. 70-71].

Continuing:

Gibbs v. Looff, No. 5143-O'C Civil, Southern District of California, Consent Judgment August 27, 1946 [offered R. 61, Plaintiff's Exhibit 4, Book of Exhibits 355];

Gibbs v. Hicks, et al., No. 5565W, Southern District of California, Consent Judgment January 21, 1947 [offered R. 62, Plaintiff's Exhibit 5, Book of Exhibit 358].

By inadvertence of Respondent's counsel, only six of the seven Consent Judgments are enumerated in the Findings of Fact [Finding VI, R. 34-35].

All these Consent Judgments were entered prior to commencement of the trial in the present case, which began February 19, 1947 [R. 55].

Gibbs authorized numerous licensed operations on royalty consideration commencing at Long Beach, California in December of 1930 and located variously in New York, Massachusetts, Connecticut, New Jersey, Ohio, California and England. The specific locations are referred to at R. 66.

Prior to the grant of the patent Gibbs made two outright sales of the patented game and, except for those two, royalties are paid on all of the licensed games [R. 67-68].

At the time of the trial in the instant case Gibbs had no knowledge of any operations which he alleged to infringe other than the game operated by Petitioner Faulkner [R. 69]. ~~In contrast to this there were approximately 1,500 authorized units then in use, a number of these units being grouped together to make one game~~ [R. 66].

Gibbs had the statutory patent notice on all games licensed or manufactured after the patent issued [R. 68].

ORIGIN AND NATURE OF PETITIONER'S GAME.

Petitioner Faulkner saw a game in operation on the Pike at Long Beach, California, operated by one Arthur Loeff and others who were later defendants in the Consent Judgment, Plaintiff's Exhibit 4. The Loeff game had been copied from a local Gibbs game [R. 80 *et seq.*], and Faulkner in turn copied the Loeff game [R. 91-93], Findings of Fact [Finding XIII, R. 38], and called his the Fawn game [R. 94].

This first Fawn game and its use by Petitioner was the subject of the Complaint in the present case. After the Complaint was filed, Petitioner made some changes and brought the modified game into the case by Counterclaim.

The original Fawn game was similar to the Gibbs patented game in all material respects, namely, it was made up of a plurality of game units each comprising a game board with holes corresponding to electric lights on an annunciator panel. A single ball was provided for the player to roll over the board and which, when dropping through a hole, would actuate an electric switch, dropping past it and returning each time to the player for a successive roll. Electrical circuits were provided whereby one of the electric lamps would be energized when the corresponding switch was closed. To hold the circuit closed, Petitioner employed a weight on the switch (instead of an electrical relay), an element known as a substitute for an electrical relay prior to the Gibbs patent (Petitioner's Brief p. 40). The circuits in the Fawn game were grouped so that when a line of lights, horizontal, vertical or diagonal, was energized a win circuit was established, a signal resulted, and the winner of a plurality of these game units, which were electrically interconnected, remained lighted after the non-winners were de-energized.

A detailed description with illustrations of the Fawn game is contained in a stipulation [Plaintiff's Exhibit 2, offered R. 56-57, text in Book of Exhibits 309].

In Petitioner's modified Fawn game the physical elements of playing board, annunciator light panel, playing balls, arrangement and grouping, remained identical. The electrical circuits remained the same with these exceptions which are immaterial: certain light bulbs were unscrewed from their circuits, one wire connection was shifted, and an electric time switch was added as an accessory. The method of play was the same as before: each player sat before his unit playing board and rolled a ball into the holes, endeavoring by repeated rolling of the ball to light up five lights in a row and thereby become a winner. All the time switch did was to limit the period in which a game could be played. That was purely an addition to, not an omission from, the primary claimed features of the Gibbs patent. Its merits or demerits are, therefore, inconsequential here.

The stipulation, Plaintiff's Exhibit 2, in conjunction with certain additional drawings and testimony, must be considered together for ascertaining the specific changes and their effect, if any.

PROCEEDINGS.

Conflicting evidence was introduced at the trial particularly with respect to the similarity or dissimilarity of the working parts and electrical circuits between the Gibbs' patent and the defendant's apparatus. The mechanisms employed in both games, being somewhat intricate, required explanation and expert testimony.

Prior art patents and a catalogue put in evidence by Petitioner were considered by the court.

Bryan R. Burke was the chief expert for the plaintiff. Respondent here. Burke is an electrical engineer holding a university degree in electrical engineering, a Master's degree in physics and mathematics, and having served as an employee of the General Electric Company and others [R. 97].

Petitioner's expert was Mr. Harold W. Mattingly, a Los Angeles patent attorney who represented the defendants in one of the Consent Judgments, *Gibbs v. Hicks, et al.* [Plaintiff's Exhibit No. 5, Book of Exhibits 358], and who appears with Mr. Robert W. Fulwider as attorney for the Petitioner in this Court.

District Judge Yankwich resolved the conflicting testimony of Messrs. Burke and Mattingly and other conflicting evidence in favor of Gibbs.

His Findings of Fact and Conclusions of Law [R. 33 *et seq.*], held the Gibbs patent valid as to claims 3 and 6 to 10, inclusive, which were the only claims in suit, and all of the claims in suit infringed by the original form of Petitioner's game, and claims 3, 9 and 10 infringed by the modified form of Petitioner's game.

In its opinion on the appeal, the Court of Appeals, speaking through Judge Bone, made reference to the findings of the District Court, summarized the same, and adopted them.

There have been no conflicting decisions involving the Gibbs patent at any time in any court.

Comment Preliminary to Argument.

Inasmuch as we do not know why this Court granted certiorari, we are at some loss to fix upon points for argument.

1. There was no conflict of decision between circuits, but on the other hand concurring decisions of the District Court in New York, *Gibbs et al. v. T. Z. R. Amusement Corporation*, *supra*, the District Court in California, *Gibbs v. Faulkner* (the present case), the latter affirmed in all respects by the Court of Appeals for the Ninth Circuit.

2. There is no important public interest in the patented invention.

3. There is no prolonged future patent monopoly involved, as the Gibbs patent expires in about eight months.

4. We can only speculate as to whether this Court desires to consider

(a) Whether the Court of Appeals erred in ruling that the questions of invention and infringement in this case are questions of fact, or

(b) Whether the Court of Appeals decided the case contrary to applicable decisions of this Court, or

(c) Whether to distinguish the case at bar from *Haliburton Oil Well Cementing Co. v. Walker et al.*, 329 U. S. 1, 91 L. Ed. 3, 67 S. Ct. 6, 71 U. S. P. Q. 175.

Items 1 to 3 are self evident, and probably regarded as secondary. We will therefore develop item 4 with its subdivisions at greater length.

Summary of Argument.

I.

Questions of invention and infringement are questions of fact, and the concurrent findings of the courts below on these issues will not be disturbed unless clearly erroneous.

II.

The findings of the courts below in favor of Respondent on the issues of invention and infringement are fully supported by the evidence, and should be sustained.

III.

The Gibbs patent claims define patentable combinations, and in holding them valid, the Court of Appeals followed applicable decisions of the Supreme Court.

IV.

If this Court's decision in *Halliburton Oil Well Cementing Co. v. Walker et al.*, *supra*, is susceptible of being construed to bar "means" claims for a combination of elements irrespective of the position of the invention in the art, such decision should be explained, clarified or distinguished, and the fundamental principles of patent interpretation announced by this Court in *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U. S. 405, 52 L. Ed. 1122, 28 S. Ct. 748, be re-affirmed as controlling in appropriate cases.

ARGUMENT.

I.

Questions of Invention and Infringement Are Questions of Fact, and the Concurrent Findings of the Courts Below on These Issues Will Not Be Disturbed Unless Clearly Erroneous.

Keyes et al. v. Grant et al., 118 U. S. 25, 30 L. Ed. 54, 6 S. Ct. 950;

Continental Paper Bag Co. v. Eastern Paper Bag Co., 240 U. S. 405, 52 L. Ed. 1122, 28 S. Ct. 748;

Thomson Spot Welder Company v. Ford Motor Company, 265 U. S. 445, 68 L. Ed. 1098, 44 S. Ct. 533;

Stilz v. United States; 269 U. S. 144, 70 L. Ed. 202, 46 S. Ct. 37;

Corona Cord Tire Co. v. Dorian Chemical Corp., 276 U. S. 358, 72 L. Ed. 610, 48 S. Ct. 380;

Sanitary Refrigerator Company v. Alexander F. Winters, 280 U. S. 30, 74 L. Ed. 147, 50 S. Ct. 9, 3 U. S. P. Q. 40;

Goodyear Tire & Rubber Co. v. Ray-O-Vac Co., 321 U. S. 275, 88 L. Ed. 721, 64 S. Ct. 593, 60 U. S. P. Q. 386;

Graver Tank & Manufacturing Company, Inc., et al., v. The Linde Air Products Company, 336 U. S. 271, 93 L. Ed. Adv. Op. 492, 80 U. S. P. Q. 451.

In *Keyes et al. v. Grant et al.*, *supra*, the case related to an improvement in lead smelting furnaces. The following language from the decision at 118 U. S. 25, 30, L. Ed. 57, is in point:

"The judgment entered on the verdict rendered in favor of the defendants, in pursuance of the direction of the court, can be maintained only on the ground, either that the legal identity of the furnace described by Karsten with that covered by the plaintiffs' patent was manifest as a matter of law; or that it was established as a matter of fact so conclusively by the evidence that a verdict the other way could not be supported, within the rule as stated in *Randall v. Baltimore & O. R. R. Co.*, 109 U. S. 478, (Bk. 27, L. ed. 1003).

Clearly it was not matter of law that the specification of the plaintiffs' patent, and the publication of Karsten, taken in connection with the drawings intended in illustration, described the same thing. The differences were obvious in the arrangement of the parts, and the relation of the basin in one, and the fore hearth in the other, to the interior of the furnace, and the mode of connecting the one with the other for the purpose of drawing the metal from the furnace. So that it certainly was not a matter of mere judicial knowledge that these differences were either not material in any degree to the result or, if material at all, were only such as would not require the exercise of the faculty of invention but would be suggested by the skill of an experienced workman employed to produce the best result in the application of the well known arrangements of the furnace.

In *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, *supra*, the case related to patent for a paper bag machine. The District Court of Maine held the patent valid and infringed, which decision was affirmed by the First Circuit Court of Appeals and subsequently affirmed by the Supreme Court. This court said, at 210 U. S. 416, 52 L. Ed. 1127:

"The lower courts, therefore, found that the invention was a broad one, and that the machine used by the Continental Company was an infringement. And these were questions of fact upon which, both of the courts concurring, their findings will not be disturbed, unless clearly wrong."

In *Thomson Spot Welder Company v. Ford Motor Company*, *supra*, the District Court for the Eastern District of Michigan dismissed a bill filed to enjoin alleged infringement of a patent. The Sixth Circuit Court of Appeals affirmed the District Court. The Supreme Court affirmed the Circuit Court.

The case related to a patent for electric spot welding said to be anticipated by prior electric welding patents. The following language at 265 U. S. 446, 68 L. Ed. 1100 is pertinent:

* * * The question whether an improvement requires mere mechanical skill or the exercise of the faculty of invention is one of fact; and, in an action at law for infringement, is to be left to the determination of the jury. *Keyes v. Grant*, 118 U. S. 25, 36, 37, 30 L. ed. 54, 57, 58, 6 Sup. Ct. Rep. 950; *Holmes v. Truman*, 14 C. C. A. 517, 29 U. S. App. 572, 67 Fed. 542, 543; *Hall v. Wiles* (C. C.), 2 Blatchf. 194, Fed. Cas. No. 5,954; *Poppenhusen v. Falke* (C. C.), 5 Blatchf. 46, Fed. Cas. No. 11,280;

Shuter v. Davis (C. C.), 16 Fed. 564, 566; *Blessing v. John Trageser Steam Copper Works* (C. C.), 34 Fed. 753, 754. Ordinarily, therefore, the case would call for the application of the well-settled rule that the concurrent findings of the lower courts on questions of fact will be accepted by this court unless clear error is shown."

This court noted an exception to the rule, *which does not apply here*, as follows:

"* * * We think, however, that this rule should not be strictly applied in cases brought here because of a conflict of decision in the different circuit courts of appeal, and have therefore given consideration to the question as to which of the decisions upon this question of fact, in the light of the prior art, is based upon the sounder reasoning."

In *Stilz v. United States*, *supra*, this court, in an appeal from the Court of Claims, stated at 269 U. S. 147, 70 L. Ed. 203:

"Infringement is a question of fact. The quoted finding is in the nature of special verdict of a jury. *United States v. Societe Anonyme des Anciens Etablissements*, 224 U. S. 309, 322, 330, 56 L. ed. 778, 785, 788, 32 Sup. Ct. Rep. 479; *Brothers v. United States*, 250 U. S. 88, 93, 63 L. ed. 859, 862, 39 Sup. Ct. Rep. 426. This Court accepts the findings of fact made by the Court of Claims and cannot review them. *Collier v. United States*, 173 U. S. 79, 80, 43 L. ed. 621, 622, 19 Sup. Ct. Rep. 330. And even where a finding determines a mixed question of law and fact, it is conclusive unless the court is able to separate the question to see whether there is a mistake of law. *United States v. Omaha Tribe of Indians*, 253 U. S. 275, 281, 64 L. ed. 901, 905, 40 Sup. Ct. Rep. 522, *Ross v. Day*, 232 U. S. 110, 116,

58 L. ed. 528, 529, 34 Sup. Ct. Rep. 233; *Whitcomb v. White*, 214 U. S. 15, 16, 53 L. ed. 889, 890, 29 Sup. Ct. Rep. 599; *Marquez v. Frisbie*, 101 U. S. 473, 476; 25 L. ed. 800, 801."

In *Corona Cord Tire Co. v. Doran Chemical Corp.*, *supra*, a case involving a chemical formula for vulcanizing rubber, the United States District Court for the Western District of Pennsylvania dismissed a bill for infringement. The Third Circuit Court of Appeals reversed the District Court and also in turn was reversed by the Supreme Court. In this case as in others the Supreme Court justified its review of the facts on the ground that there was a conflict in cases in the courts below, stating as follows at 276 U. S. 375, 72 L. Ed. 616:

"It is also claimed that because the trial court in this cause found, after hearing the witnesses, the weight to be with the petitioner and against Weiss, assignor of respondent, his conclusions of fact, except for manifest error, are to be treated as unassailable. *Addamson v. Gilliland*, 242 U. S. 350, 353, 61 L. ed. 356, 357, 37 Sup. Ct. Rep. 169; *Davis v. Schwartz*, 155 U. S. 631, 39 L. ed. 389, 15 Sup. Ct. Rep. 237; *Kimberly v. Arms*, 129 U. S. 512, 32 L. ed. 764, 9 Sup. Ct. Rep. 355; *Tilghman v. Proctor*, 125 U. S. 136, 149, 31 L. ed. 664, 668, 8 Sup. Ct. Rep. 894, and *Mason v. United States*, 260 U. S. 545, 556, 67 L. ed. 396, 400, 43 Sup. Ct. Rep. 200. We do not think that this rule applies in the case before us at least to its full extent, first, for the reason that the circuit court of appeals, having considered all the evidence upon which the trial judge reached his conclusion, declined to approve of his findings, and second, because in the *National Aniline & Chemical Co. Case*, which is in conflict with the case here, the trial judge reached a different conclusion on the

same issue and the same evidence which we have here."

The attitude of the Supreme Court on the point under discussion is well summed up in the case of *Sanitary Refrigerator Company v. Alexander F. Winters, supra*. The Seventh Circuit Court of Appeals concurred with the District Court of Wisconsin holding a patent to be valid and infringed. The Third Circuit Court of Appeals affirmed a decree of the District Court for the Eastern District of Pennsylvania holding the patent not infringed. The Supreme Court affirmed the Seventh Circuit Court decision and reversed the Third Circuit decision. In justifying its right to review questions of fact the Supreme Court called attention to the rule that matters of infringement were questions of fact but that the rule against disturbing questions of fact did not apply in the case of a conflict. The language of this court at 280 U. S. 35, 74 L. Ed. 153, is pertinent:

"So far as this question is concerned there is no substantial difference in the evidence in the two cases. As there was a concurrent finding in the two lower courts in the Sanitary case that they were infringed, and a concurrent finding in the two lower courts in the Dent case that they were not infringed, and the cases have been brought here because of the conflict of decision in the two circuit courts of appeals, it is clear that under these circumstances, neither properly calls for the strict application of the general rule as to the acceptance by this court of the concurrent findings of the lower courts on questions of fact, and we consider independently the question as to which of the decisions on this question is based upon the sounder reasoning and is correct."

In *Goodyear Tire & Rubber Co. v. Ray-O-Fac Co., supra*, the District Court for the Eastern District of

Illinois held a narrow patent for a flashlight battery valid and infringed? The Seventh Circuit Court of Appeals affirmed the District Court and the Supreme Court affirmed.

The Supreme Court called attention to the fact that the District Court judge made findings, which had support in the evidence relating to the question of invention and also with respect to the charges of infringement. This Court then said at 321 U. S. 278, 88 L. Ed. 724:

"The Circuit Court of Appeals re-examined the findings in the light of the evidence and accepted them. It must be a strong case in which this court will set aside these concurrent findings of two courts."

After further comments, the Court stated,

"Accepting, as we do, the findings below, we hold the patent valid and infringed."

The latest pronouncement by the Supreme Court on this point which we have noted is *Grayer Tank & Manufacturing Company, Inc., et al. v. The Linde Air Products Company, supra*, decided February 28, 1949, in which this Court, dealing with patents on electric welding, held certain claims valid and infringed and other claims invalid.

Mr. Justice Jackson, speaking for seven members of the Court, quoted that part of Rule 52(a) of the Federal Rules of Civil Procedure which reads:

"Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses."

After quoting the foregoing, the opinion continued:

"To no type of case is this last clause more appropriately applicable than to the one before us, where

the evidence is largely the testimony of experts as to which a trial court may be enlightened by scientific demonstrations. * * * **A court of law, such as this Court is, rather than a court for correction of errors in fact finding, cannot undertake to review concurrent findings of fact by two courts below in the absence of a very obvious and exceptional showing of error.** *Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, 321 U. S. 275 (60 U. S. P. Q. 386); *District of Columbia v. Pace*, 320 U. S. 698; *Williams Mfg. Co. v. United Shoe Machinery Corp.*, 316 U. S. 364 (53 U. S. P. Q. 478); *Baker v. Shofield*, 243 U. S. 114, 118." (Emphasis ours.)

We are informed that a rehearing has been granted, but not on this legal question.

Messrs. Justices Black and Douglas dissented from this holding on the ground that determination of the ultimate question of patentability cannot properly be classified as a finding of fact as to which the Supreme Court will accept concurrent findings, but that whether the thing patented amounts to a patentable invention is a question of law to be decided by the courts as such. They agreed, however, that the facts justified the holding that there was patentable discovery.

With due respect to the dissenting Justices, it must be emphasized that this Court has never deviated from and has thus recently reaffirmed by seven to two the rule that, in the absence of other conflicting decisions, the concurrent findings of the District Court and the Court of Appeals on questions of invention and infringement will not be reviewed by the Supreme Court in the absence of a *very obvious and exceptional* showing of error.

II.

The Findings of the Courts Below in Favor of Respondent on the Issues of Invention and Infringement Are Fully Supported by the Evidence, and Should Be Sustained.

A. Invention Is Clearly Present Over the Prior Art.

The prior art patents were offered as a book [Defendant's Exhibit D, R. 179, copies in Book of Exhibits 373 *et seq.*]. We will discuss them briefly.

Nakashima, No. 1,678,573 [Book of Exhibits 376] was a Gibbs file wrapper reference, and was named by Petitioner Faulkner's expert, Mr. Harold W. Mattingly, as one of the closest prior patents [R. 214]. He urged that Gibbs claim 3, which covers a single game unit, is basically the old Nakashima game. In this he was in error, as three courts have decided. Nakashima was before the District Court in *Gibbs et al. v. T. Z. R. Amusement Corporation, supra*, as well as in the present case.

All that Nakashima discloses for the purpose of this case is a game which involves rolling several balls into pockets, and a visible signal or signals in an annunciator. The Nakashima amusement device is a single unit in which a player has *three* balls to roll. When a ball enters a pocket it lodges there, is not returnable to the player, and may or may not encounter a switch in a live circuit. The ball must remain in the pocket to hold the switch closed, and if the player rolls the three balls and none of them happen to enter a live circuit pocket, no lights are illuminated.

In the Gibbs game a single ball (an object moved over the board by a player as described in claim 3) is used which, having entered a hole and having actuated an electric switch, returns to the player for a re-play.

This is referred to in the claim by the language "a board having a plurality of contact devices thereon adapted to be engaged by an object moved over the board by a player." Thus the claim in its inception distinguishes and departs from the principal construction and function of the Nakashima prior art patent.

Claim 3 further specifies that the indicators and the contact devices *correspondent* in number and arrangement and are subdivided into *corresponding groups*. Nakashima, upon which Petitioner so heavily relies, does not have that feature. The location of the switches for live circuits in Nakashima has no relation to the location of the lights on the panel at the end of the game board. Nakashima's whole game object is merely to roll three balls into three live switch pockets, respectively, avoiding having the balls enter dead pockets, and light up *any three* lights on the back board. Nakashima completely fails to anticipate that portion of Gibbs claim 3 preceding the clause "means for energizing" where, says the Petitioner, erroneously, the novelty lies.

Gibbs claims 6 to 10 relate to the game composed of a series of interconnected game units. A switch once actuated remains to the credit of the player by the corresponding lamp remaining energized, and a player may continue successive rolls of the ball, observe the progress of the annunciator by the lighting up of the electric lamps and thus endeavor by proper propulsion and direction of the ball to achieve a winning row either horizontal, vertical or diagonal. He continues this effort in competition with other players operating on identical units, all of the units being electrically interconnected. Nakashima is completely lacking in any such features.

Hayashi No. 1,614,471 [Book of Exhibits 383] discloses what is called a Japanese Peanut Ping Pong Game in which the playing board is inclined downwardly away from the player instead of upwardly from, as in Gibbs, so that the objects played with are not returnable to the player. He is provided with three objects in the form of peanuts which are weighted so that, as the patentee says, instead of rolling in a direct path they will zig zag not only down the board but also partly across the same and never take the same course twice in succession [Patent, p. 1, lines 53-56]. When the three peanuts or whatever number may be allocated to the player have been projected the game is over and the player is credited by adding up the values attributed to the particular lights which have been illuminated. The weighted peanuts have to remain in the pockets in order to keep the lights lighted. Hayashi is therefore less pertinent to Gibbs than is Nakashima.

Esmarian No. 1,612,912 [Book of Exhibits 391] which was summarily disposed of by the District Court in *Gibbs v. T. Z. R. Amusement Corporation, supra*, as being even more remote from Gibbs than Nakashima, makes provision for a plurality of balls to roll over a tally board to register a score. Any ball which falls into a pocket must remain there to maintain the electric switch closed, and the only balls which are returned to the player for re-rolling are those which have not entered a pocket. It further lacks Gibbs' features in that it is shown as a single unit and no suggestion is made of electrically inter-connecting a plurality of units for competitive purposes, and it does not have an annunciator panel and arrangement of the Gibbs character wherein horizontal, vertical or diagonal lines of light are energized to create a winner.

Mader No. 1,622,330 [Book of Exhibits 397] adds nothing to the prior patents already discussed. This conclusion is confirmed by reference to Petitioner's Brief, page 15, where counsel says regarding Mader that "it likewise shows a game board," etc., and his description points up nothing in Mader not shown Hayashi or Esmarian.

Schneider et al., No. 1,788,336 [Book of Exhibits 408] shows an electric ski ball game, its principal contribution, as pointed out by Petitioner in his brief at page 16, apparently being the fact that a single ball is used which returns to the player after it has actuated a switch located below one of the rings which are arranged in the conventional ski ball pattern.

McGregor No. 1,260,691 [Book of Exhibits 411] illustrates a target apparatus wherein each of a plurality of targets is normally illuminated, and bullet impact on the target operates an electric switch to de-energize the lamp of that particular target.

Chester No. 1,598,711 [Book of Exhibits 424] is not a ball rolling game but is said to be in the nature of a test of the player's sense of timing by his operation of a hand-wheel which he endeavors to synchronize with the beat of a musical composition played by a mechanical piano or organ.

Wallace No. 1,697,701 [Book of Exhibits 436] illustrates a plurality of race tracks over which pigs are chased by farmers.

Higuchi No. 1,454,968 [Book of Exhibits 450] substitutes rabbits for pigs.

Prina et al., No. 1,518,754 [Book of Exhibits 470] shows a series of lamps, the last lamp of the series being

the goal, and the mechanism is so arranged that in order to reach the goal and win a game the winning player must operate a crank with a gradual acceleration up to about the time that the last lamp is mechanically reached and thereafter he must maintain for a predetermined length of time a uniform speed in order to cause his winning lamp to be lighted [Patent, p. 1, lines 31-40].

Irsch et al., No. 1,458,884 [Book of Exhibits 486] is not the same Irsch patent referred to in *Gibbs et al. v. T. Z. R. Amusement Corporation, supra*, but has a cut-off feature similar to that noted by Judge Byers in his opinion in that case. The present Irsch patent is characterized by ducks on wheels mounted on tracks which are propelled under efforts of the players, the winner being the one who causes his duck to travel the full length of a track and causes the egg on the duck to be discharged into a nest or cup which actuates an electric switch.

Chester, Wallace, Higuchi, Prina, and Irsch are apparently relied upon by Petitioner on the proposition that each of these patents provides an electric circuit open until a win has been made and that when there is a winner a light or a bell rings. What Petitioner, of course, fails to emphasize is the fact that *every one of these discloses a game apparatus entirely different from that of Gibbs.*

The Petitioner's contention that it was not invention at the time Gibbs entered the field to add the win signal circuits of the multi-unit games above discussed to the board and ball game units of Nakashima, Hayashi, Mader, and Esparian, or the converse, is defective in two respects: (1) The Nakashima type of game is not the Gibbs type of game, nor is the Chester type of game the Gibbs type of game, and the combination of these two types is neither obvious nor suggested, nor feasible. The players of the

Gibbs type game complete for a result which is achieved through the exercise of skill in illuminating five annunciator lights in a row, horizontal, vertical, or diagonal, and when this has been accomplished a signal light or supplemental signaling means marks the winning annunciator panel and thereafter maintains the illumination of the winning annunciator panel while the non-winning panels are cut off either simultaneously or at the termination of a playing period as determined by an electric time switch (as in the "new" Fawn game), and since such a combination is neither suggested, nor obvious, nor feasible, when taking into consideration all of the prior art games, the contention of the Petitioner must fall of its own weight.

Steinmetz No. 1,630,869 [Book of Exhibits 496] illustrates an electrical baseball game. **Blackmore No. 1,280,136** [Book of Exhibits 515] is a patent for a rain signal, wherein drops of rain fall into a spoon and close a switch to ring a bell, and **Lynch No. 1,685,329** [Book of Exhibits 519] illustrates an electric alarm mechanism. Why these three patents are in the record we do not learn from an examination of Petitioner's Brief, and we will not take the time of this Court to further discuss them.

The foregoing constitutes all of the prior art in the record here. An examination of such art furnishes ample support for Finding of Fact No. X in this case [R. 36], that none of the aforesaid prior art patents or the catalog (the latter is not included in the record on appeal) disclose or anticipate or suggest either singly or collectively the subject matter of the Gibbs patent No. 1,906,260 and furnish no basis for any finding or conclusion that the Gibbs patent lacks invention.

B. Other Evidence Supports Invention.

The fact of prior adjudication in *Gibbs et al. v. T. Z. R. Amusement Corporation et al.*, is undisputed.

Evidence of the Consent Judgments and licensed operations is uncontradicted.

Public acquiescence except infringement by Petitioner Faulkner stands as an uncontroverted fact.

Findings V, VI and VII [R. 34-35], on these facts, cannot be assailed. Such facts lend support to the primary Finding X that the Gibbs patent displays invention.

C. Infringement of Claims 3 and 6 to 10 by Manufacture and Use of the First Fawn Game, and of Claims 3, 9 and 10 by the Second Fawn Game Was Fully Established.

The Gibbs claims in suit were not narrowed in the face of any rejections, and no file wrapper estoppel can be invoked to restrict them.

Claim 3 was originally numbered 9; it was rejected only for a technical defect, the Examiner saying (file wrapper, page 26) that in line 10 the circuit mentioned is but indirectly introduced. A slight correction resulted in allowance. [The file wrapper was received as Defendant's Exhibit C, R. 177. It is a physical exhibit not copied in the Book of Exhibits.]

Claims 6 (original 12), 7 (original 13), 8 (original 15), 9 (original 16), and 10 (original 17) were allowed as originally filed.

The claims in suit are therefore entitled to be read as covering a game apparatus of the kind described without any implied limitations.

Petitioner has apparently abandoned any contention that the Fawn game does not infringe the claims, his defense

being that the claims are invalid because they contain some functional language. He virtually admits infringement by stating in his brief, page 28: "If claim 3 were in non-functional language * * * it could not be infringed by either Fawn game, since they do not employ relays to energize their indicators." Regarding claims 6-10, he states, same page, "If these claims were written in non-functional language they would not be infringed by either Fawn game."

In applying the claims, we may take as a premise that all claims in suit *read upon* the first Fawn game, and that the elements of the claims as illustrated in the Gibbs patent *are all found in substance* in the Fawn game and in the same-relationship.

There is but one difference which need be discussed. In claim 3, Gibbs' "means for energizing said indicators as the associated contact devices are operated" is illustrated in the patent and claimed in claim 1, not in suit, as comprising relays. In the Fawn game, overbalanced or weighted switches are substituted for relays. However, overbalanced switches were known as equivalents of relays at the date of the Gibbs patent [Petitioner's Brief, p. 40, citing Schneider patent, R. 408, and Blackmore patent, R. 515], so the difference is immaterial on the question of infringement.

The word "means" in claim 3 must be construed more broadly than the corresponding word "relays" in claim 1, and such word "means" comprehends an overbalanced or weighted switch as an equivalent.

Claim 6 covers a game of Gibbs units interconnected and embodying

"means whereby when all of the indicators in any group of any one of said units have been operated

to complete a winning play, the indicators on all of the units except the winning unit will be deenergized, while the indicators at the winning unit will remain energized, for the purpose described."

This element is primarily the circuit which is established upon a win combination, a relay in which cuts off the non-winning enunciator light circuits and maintains the win unit enunciator lights energized.

The identical element is present in the first Fawn game.

Claim 7 adds to claim 6 an *independent* supplementary signal at each of the units for signaling a winning play to the players.

This signal may be identified as the signal lamp on top of each unit, which is present in the patent game, and was also present in the first Fawn game.

Claim 8 builds upon claim 7, means under the control of an operator for opening and closing the circuits of all of the units simultaneously at will.

This means is a master switch, present in both the patent and in the first Fawn game.

Claim 9 has some of the principal elements of claim 6 in that it defines a plurality of electrically connected units (of the order of claim 3), but is broader than claim 6 in the final element "*means controlled by [emphasis added] the closing of the signal circuit of the winning unit for discontinuing the signals and opening the circuits of the indicators on all other units.*"

Thus, claim 9 is infringed by the first Fawn game, which it obviously comprehends in view of the discussion of claim 6.

Respondent's expert, Bryan R. Burke, compared the Gibbs patent game and the first Fawn game [R. 98 *et seq.*] and concluded that the two seemed to him "to be almost exactly the same" [R. 102]. His testimony conflicted with that of Harold W. Mattingly, Petitioner's attorney and expert, and the District Court *resolved the conflict by adopting Burke's testimony.*

The District Court in its Finding XII, at R. 38, stated:

"The original Fawn game embodies the subject matter of the Gibbs patent No. 1,906,200 as defined in Claims 3, and 6 to 10, both inclusive. * * *"

When we come to apply claims 3, 9 and 10 to the second Fawn game, we find identical comparative elements, with some inconsequential variations.

In respect to claim 3, Petitioner says (Brief, p. 28), that he does not infringe because he uses no win light or bell. This refers to the element in claim 3, "supplemental means for indicating a winning play when all of the indicators in one of said [win] groups have been energized." Petitioner admits that his signal lamps of the first game fulfilled this definition, but because he altered the game by unscrewing the bulbs says that he now has no supplemental means.

He ignores the rule that the claims of a patent are to be distinguished. Applying this rule, we call the Court's attention to the corresponding feature closely defined in claim 2 (not in issue) as "a master signal." It is obvious upon inspection that "supplementary means for indicating" is a broader term. No such things as a *master signal* lamp or bell are required. The Petitioner employs a relay which makes an audible clicking sound and flickers the lights in the winning unit. His excuse

that this occurs because he uses cheap delays is feeble indeed. It is what elements are present, and how they operate, that controls, not the reasons why he does not employ something which would not infringe.

The fact that the relay which makes the noise and flickers the lights is located in the circuit common to all the groups referred to above, does not avoid infringement. The same relay is, and has to be, also located in another circuit from which it derives its actuating energy. The presence of the relay, and its operation when energized by the completion of a win group, constitutes a supplementary means for indicating a winning play. In showing one to be equivalent to the other, it is not necessary that the infringing elements, especially if they are electrical circuits, can be matched by superimposing a diagram of one over the other and finding no deviation. Such would hardly ever be possible. It is sufficient that the purpose, result and means are similar.

Regarding claims 9 and 10, Petitioner argues that they cannot be infringed by the second Fawn game because claims 6, 7 and 8 were held not infringed by it. Petitioner, however, falls into an error in construing these claims. The holding of claims 9 and 10 to be infringed was correct and is supported by the evidence. Only claims 6 and 9 need be discussed in this connection, as claims 7 and 8 are dependent upon claim 6, and claim 10 is dependent upon claim 9.

Referring back to claim 6, the transfer circuit functions by reason of or by action of the completion of a win circuit, and is constituted to perform two functions: i.e. (1) to deenergize the non-winners, and (2) to maintain the win unit energized. In claim 9, the same general

circuit is described more broadly, and functions not by reason of or by action of the completion of a win circuit, but is *merely controlled by* a win circuit, and need be constituted to perform only *one* function, *i. e.*, to control or condition the opening of the non-winner circuits. The same meaning as "controlled by" would be properly expressed as *conditioned by*. It controls to the extent of severing the circuits and thus conditioning the win circuit to remain energized, the others to be deenergized when the time switch is thrown.

Thus, claim 9 is infringed not only by the old Fawn game, which it obviously comprehends in view of the discussion of claim 6, but is also infringed by the "altered" Fawn game.

In this "altered" Fawn game, the circuit which opens the non-winner circuits is *prepared or conditioned by*, and consequently *controlled by*, the win circuit or circuits. The time switch, which is merely an accessory, may delay the action, but when a pre-determined time elapses, the cutoff circuit functions under the control of the win circuit or circuits. Claim 9 is thus clearly infringed by the second Fawn game.

Claim 10 adds to claim 9 the audible signal, present in both Fawn games, and thus is infringed by both.

The point regarding claims 9 and 10 raised by the Petitioner discussed here, even if he were correct, would not affect the Judgment of the District Court and of the Court of Appeals, since claim 3 is not involved in the point, and the Judgment would stand on the basis of claim 3 being valid and infringed by both forms of Petitioner's games.

Respondent's expert, Burke, discussed the second Fawn game in detail, beginning at R. 119. He pointed out that the game boards, arrangement of holes, plunger, single ball, annunciator, and annunciator lights were exactly the same as in the first Fawn game. Certain signal lamps had been unscrewed, but surplus lamps were present and usable. The signal wiring was intact. A timing control had been added, and the terminal of one wire in the system changed. The system could be restored in a few minutes to its exact original operation by changing back the wire terminal referred to, and screwing in the signal lights.

Burke discussed the points wherein Petitioner was urging the fiction that the "changes" had made a different game out of it, and concluded [R. 125], that the altered game was similar to the Gibbs patent in structure, function and result.

Mr. Mattingly's conclusions conflicted with this, and the District Court *resolved the conflict in favor of Gibbs by adopting Burke's testimony.*

The District Court, in its Finding XII, at R. 38, stated:

"* * * and the altered Fawn game embodies the subject matter of the Gibbs patent as defined in claims 3, 9 and 10."

The equities as between Gibbs, the Respondent, and Faulkner, the Petitioner, are all in favor of Gibbs. Such equities have been recognized by the three concurrent findings and judgments of the courts below. It remains to be analyzed whether Gibbs' patent claims in suit are, as charged by Petitioner, technically defective in form, thereby depriving him of his just due. We proceed to this consideration, under the two following points of argument.

III.

The Gibbs Patent Claims Definite Patentable Combinations, and in Holding Them Valid, the Court of Appeals Followed Applicable Decisions of the Supreme Court.

HISTORICAL SKETCH.

The patent laws are derived from the authority of the Constitution, Article I, Section 8, Clause 8, which reads:

"The Congress shall have power * * * to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their ~~respective~~ writings and discoveries."

The first patent statute was the Act of 1790 which required:

"A specification in writing, containing a description, accompanied with drafts or models, and explanations and models (if the nature of the invention or discovery will admit of a model), of the thing or things by him or them invented or discovered, and described as aforesaid, in said patents; which specification shall be so particular, and said models so exact, as not only to distinguish the invention or discovery from other things before known and used, but also to enable a workman or other person skilled in the art of manufacture, whereof it is a branch, or wherewith it may be nearest connected, to make, construct or use the same, to the end that the public may have the full benefit thereof, after the expiration of the patent term; . . ."

The Act did not refer to nor require any claims.

Section 3 of the Act of 1793 provided:

"That every inventor before he can receive a patent shall deliver a written description of his invention, and of the manner of using, or process of compounding the same, in such full, clear, and exact terms, as to distinguish the same from all other things before known . . ."

The Act of July 3, 1832, which first provided for the reissue of patents, did not mention claims.

The first reference to patent claims occurred in the Act of 1836, Section 6 of which provided that the applicant

"shall particularly specify and point out the part, improvement, or combination, which he claims as his own invention or discovery."

From 1836 until about the time of the Act of 1870 it was the common practice to add to the descriptive portion of the specification a single claim, although occasionally two or more were presented. The form of these early claims was specific, classified by Ridsdale Ellis¹ as "central definition" claims.

Specimen claims under the central definition system may be found in the patent in suit in *Rees v. Gould*, 15 Wall. 187, 21 L. Ed. 39, 40. These claims read as follows:

First: The flanges *i* on the reversing crank or arm *b* and the projection *t* on the cam-rod *c* when used for the purpose of guiding the hooks 1 and 2 into their proper position on the wrists 3 and 4 of the reversing crank or arm *b*, as herein described and set forth.

¹Patent Claims, by Ridsdale Ellis published by Baker, Voorhis & Co., Inc., New York, 1949.

Second. The use of the link *m*, or its equivalent when used in connection with the cam-rods *f* and *g*, reversing crank or arm *b*, and the crank or arm *l* as herein described and for the purpose set forth.

Third. The use of the connecting rods *o* and *g*, or their equivalents, when used in combination with the link *m*, cam-rod *c*, and levers *p* and *r*, as herein described and for the purpose set forth.

In construing these claims Mr. Justice Clifford formulated a doctrine of equivalents by instructing the jury that the withdrawal of one ingredient in a patented combination and the substitution of another which was well known at the time of the patent as a proper substitute for the one withdrawn is a mere formal alteration of the combination and if the ingredient substituted performed substantially the same function as the one withdrawn such a substitution of one ingredient for another would not avoid the charge of infringement.

The Rules of Practice of the Patent Office published August 1, 1869 contained the following sample claims:

"I claim as my invention:

First—The combination of the cutters *EE*, and the feeding rollers *II* and *JJ*, substantially as and for the purpose hereinbefore set forth.

Second—The combination with the cutters *EE*, and feeding rollers *II* and *JJ*, of the cutters *L* and *M*, substantially as and for the purpose hereinbefore set forth."

The Act of 1870 advanced the importance of claims in the patent by providing that the inventor or discoverer "shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery;"

This law for the first time required the patent claims to "distinctly claim" the invention; whereas, the Act of 1836 only required that the applicant should particularly specify and point out the invention. Since the Act of 1870 the claim has come to be regarded as the most important part of a patent; at least it is the element of the patent upon which in most cases the patent either stands or falls.

After the passage of the Act of 1870 claims were drawn in the form which Ridsdale Ellis denotes "peripheral definition." Whereas, central definition is illustrated by a specific claim usually with reference characters, reliance being placed upon the court for a broad interpretation to include equivalents, peripheral definition is, as stated by Ellis, the "marking out the periphery or boundary of the area covered by the claim and holding, as infringements only such constructions as lie within that area."

For sometime after the Act of 1870 there was a transitional period from central claims to peripheral claims, some of the latter even including reference characters. Also, patents began to appear with a greater number of claims, because under the peripheral claim system it became necessary to claim the invention in various ways to have different claims of different scope and also to protect all different features disclosed in the drawings and description.

From about 1920 on no patents were issued with claims having reference characters therein.

Under the old central definition system only a Chinese copy would literally infringe a claim and therefore the courts considered whether the definition should be expanded to cover the alleged infringement.

Under the peripheral definition system the courts proceed from the question whether the inventor has claimed his subject too broadly. If claimed too broadly, the claim may be invalid because (a) it embodies what is old in the art and is therefore void for anticipation or want of invention, or (b) it embraces subsequent independent inventions of others and therefore covers more than the patentee invented.

RELEVANT STATUTES CURRENTLY IN FORCE.

The following laws are currently in effect, and are controlling, the changes made by amendment since the Gibbs patent application was filed, having no bearing on the case.

35 U. S. C. 31; R. S. 4886:

"Any person who has invented or discovered any new and useful art, machine, ~~manufacture~~ or composition of matter, or any new and useful improvements thereof * * * not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have

been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

35 U. S. C. 33; R. S. 4888.

"Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery * * *"

It should be noted that the clause setting forth the requirements of claims is identical with that of the Act of 1870.

FUNDAMENTAL SUPREME COURT DOCTRINE.

In *Bates v. Coe*, 98 U. S. 31, 25 L. Ed. 68, 71, this Court, speaking through Mr. Justice Clifford, in 1878, summarized the philosophy of patent disclosures and claims in the following language:

"In case of a claim for a combination, where all the elements of the invention are old, and where the invention consists entirely in the new combination

of old elements or devices whereby a new and useful result is obtained, such combination is sufficiently described if the elements or devices of which it is composed are all named and their mode of operation given, and the new and useful result to be accomplished pointed out, so that those skilled in the art and the public may know the extent and nature of the claims, and what the parts are which cooperate to produce the described new and useful result. Curtis, Pat., 4th ed., sec. 289a, p. 275; Seymour v. Osborne, 11 Wall. 542 [78 U. S., XX, 38.]”

The court explained the purposes of the requirement in the following language:

“Accurate description of the invention is required by law, for ~~several~~ important purposes: (1) That the government may know what is granted and what will become public property when the term of the monopoly expires. (2) That licensed persons desiring to practice the invention may know, during the term, how to make, construct and use the invention. (3) That other inventors may know what part of the field of invention is unoccupied. Gill v. Wells, 22 Wall. 27 [89 U. S., XXII., 711]. * * *

The law of that case has been re-affirmed by this Court many times. A few leading examples will be cited.

In *Morley Sewing Machine Company, et al., Appts. v. Charles B. Lancaster*, 129 U. S. 263, 32 L. Ed. 715, 716, 9 S. Ct. 279, the claims held valid were as follows, these being quoted (emphasis added) to illustrate the general language approved as permissible in combination claims:

“1. The combination, in a machine for sewing shank buttons to fabrics, of button-feeding mechanism, *apparatus* for passing a thread through the eye

of the buttons and locking the loop to the fabric, and feeding *mechanism*, substantially as set forth."

"2. The combination, in a machine for sewing shank-buttons to fabrics, of a needle and operating *mechanism*, *appliances* for bringing the buttons successfully ~~to~~ positions to permit the needle to pass through the eye of each button, and *means* for locking the loop of thread carried by the needle to secure the button to the fabric, substantially as set forth."

"8. The combination, in a machine for sewing buttons to fabrics, of button feeding, and sewing *appliances*, substantially as set forth, and feeding *appliances* and operating *mechanism* whereby the feeding devices are moved alternately different distances to alternate short button stitches with long stitches between the buttons, as specified."

"13. The combination, with button-sewing appliances, of a trough, *appliances* for carrying the buttons successively from the trough to the sewing devices, and *mechanism* for operating said appliances and sewing devices, as set forth."

THE PAPER BAG CASE.

One of the landmarks of the patent law is the Supreme Court opinion in *Continental Paper Bag Company v. Eastern Paper Bag Company*, *supra*, 210 U. S. 405, 52 L. Ed. 1122, 1127, 28 S. Ct. 748 (1908).

In that case the defense of want of invention was not urged before this Court, but the contention of defense counsel that "the circuit court, in its decision, virtually gave Liddel a patent for a function by holding that he was entitled to every means to cause the forming plate to oscillate about its rear edge," was a direct attack upon the

validity of the patent if construed broadly enough to be infringed.

The patent in suit was one granted to William Liddel for an improvement in paper bag machines. Claim 1 was selected as typical and read as follows (emphasis added):

"In a paper bag machine, the combination of a rotating cylinder provided with one or more pairs of side-folding fingers adapted to be moved toward or from each other, a forming plate also provided with side-forming fingers adapted to be moved toward or from each other, *means for operating* said fingers at definite times during the formative action upon the bag tube, *operating means for* the forming plate adapted to cause the said plate to oscillate about its rear edge upon the surface of the cylinder during the rotary movement of said cylinder; the whole operating for the purpose of opening and forming the bottom of the bag tube, and *means to move* the bag tube with the cylinder."

Reviewing this and the other claims in suit, the court referred to Revised Statutes, Sec. 4888 (35 U. S. C. 33) and quoted the same in a footnote.

In affirming the lower courts, and holding the patent to be infringed, Mr. Justice McKenna said (U. S., p. 420, L. Ed., p. 1129):

"The circuit court said that the 'pith' of the invention 'is the combination of a rotating cylinder with means for operating the forming plate in connection therewith, limited, however, to means which cause the plate to oscillate about its rear edge on the surface thereof,' and distinguished the invention from the prior art, as follows: 'Aside from the cylinder and the forming plate oscillating about its rear edge,

everything in these claims [the claims of the patent] is necessarily old in the arts.' It was this peculiar feature of novelty, it was said which clearly distinguished it from all that went before it. This conclusion was in effect affirmed by the circuit court of appeals. The latter court said that the folding of the bottoms of S. O. S. paper bags had been accomplished in the prior art 'both by a folding plate reciprocating upon a plane and by the operation of fingers upon a cylinder. The folding plate and the cylinder had never been combined.' * * *

"The distinction between a practically operative mechanism and its function is said to be difficult to define. Robinson, Patents, §§144 *et seq.* It becomes more difficult when a definition is attempted of a function of an element of a combination which is the means by which other elements are connected and by which they coact and make complete and efficient the invention. But abstractions need not engage us. The claim is not for a function, but for mechanical means to bring into working relation the folding plate and the cylinder. This relation is the very essence of the invention, and marks the advance upon the prior art. It is the thing that never had been done before, and both the lower courts found that the machines of the Continental Company were infringements of it. It is not possible to say that the findings of those courts on that fact or on the fact of invention were clearly wrong, notwithstanding the great ability of the argument submitted against them."

This decision has been cited over and over again as authority for sustaining combination claims in which "means" followed by a functional statement identifies elements of the combination. We will later advert to this.

DEFINITION OF COMBINATION.

This Court defined what is a combination, and distinguished a combination from its elements, in *Leeds & Catlin Co., Petitioner v. Victor Talking Machine Company et al.*, 213 U. S. 301, 53 L. Ed. 805, 29 S. Ct. 495. A patent on a sound reproducing apparatus was involved. The court, speaking by Mr. Justice McKenna, used the following language:

"A combination is a union of elements, which may be partly old and partly new, or wholly old or wholly new. But, whether new or old, the combination is a means—an invention—distinct from them. They, if new, may be inventions and the proper subjects of patents, or they may be covered by claims in the same patent with the combination."

"But whether put in the same patent with the combination or made the subjects of separate patents, they are not identical with the combination. To become that they must be united under the same co-operative law. Certainly, one element is not the combination, nor, in any proper sense, can it be regarded as a substantive part of the invention represented by the combination, and it can make no difference whether the element was always free or becomes free by the expiration of a prior patent, foreign or domestic. In making a combination, an inventor has the whole field of mechanics to draw from. This view is in accordance with the principles of the patent laws."

GIBBS' GAME IS A TRUE COMBINATION.

Having these principles in mind promulgated by this Court, and standing at the roots of our patent system, we turn the spotlight on the subject matter of the Gibbs patent.

It is a game apparatus, a "union of elements" which are "wholly old."

A game board and a ball to roll are much older than the bowling green of Rip Van Winkle. Electric lamps were invented by Edison. Electric switches, relays, insulated wire, in fact all the constituents of the Gibbs game apparatus, were old. Gibbs drew freely from the "field of mechanics." It was the union of the elements in the manner taught by Gibbs which resulted in the new game combination.

It was different from any game apparatus known before. None of the prior art game apparatus could be used to play the Gibbs game. Parts or elements might be borrowed and rearranged and reassembled, but a stock pile of elements does not negative a new combination.

The thing as an entity must be regarded. This is not a case where Gibbs added something to Nakashima to make Nakashima's apparatus work better. It is a complete departure from Nakashima. Whether Gibbs, or one who copies Gibbs, employs a particular kind of an electric bulb, for example, is beside the point. Whether he uses an electric holding relay to maintain a light circuit closed, or a weighted switch, is inconsequential, so long as it performs its function cooperatively with the other elements, acting under given conditions to produce the specified result.

"Whether the parts are new or old, the combination is the invention and it is distinct from any of them." See *Schumacher v. Cornell*, 96 U. S. 549, 554; *Rowell v. Lindsay*, 113 U. S. 97, 101." Mr. Justice Douglas, in *The Mercoid Corporation v. Mid-Continent Investment Company et al.*, 320 U. S. 661, 667; 88 L. Ed. 376; 64 S. Ct. 268; 60 U. S. P. Q. 21, 25.

"MEANS" CLAIMS FOR COMBINATIONS
HAVE THE SUPREME COURT'S APPROVAL

In the *Morley Sewing Machine* case, *supra*, claim 1 contained three "means" elements:

- (1) button-feeding mechanism
- (2) appliances for passing a thread, etc.
- (3) feeding mechanism, etc.

In the *Paper Bag* case, *supra*, claim 1 contained as elements:

- (1) means for operating said fingers at definite times, etc.
- (2) operating means for the forming plate adapted to cause, etc.
- (3) means to move the bag tube, etc.

This Court had before it in 1941 the Nelson patent 2,109,678 for an electrical contact mechanism for use on pin-ball game boards, in the case of *Exhibit Supply Co. v. Ace Patents Corp. et al.*, 315 U. S. 126, 80 L. Ed. 736, 62 S. Ct. 513.

No question of invalidity was decided in view of the restriction of the questions presented on appeal to that of infringement. The only consideration of validity was by Mr. Justice Black, dissenting, Mr. Justice Douglas, concurring, both of whom would have declared the patent invalid as lacking in both invention and discovery. The claim which was considered and construed by the majority as infringed by certain structures read as follows (emphasis ours):

"4. In a ball rolling game having a substantially horizontal table over which balls are rollable, the combination with said table of a substantially vertical standard anchored in said table with its lower end

carrying on the underside of the table a lead for an electric circuit and its upper end extending a substantial distance above the top surface of the table, a coil spring surrounding the standard, *means* carrying said spring pendarily from the upper portion of the standard above the table with the coils of the spring spaced from the standard to enable the spring to be resiliently flexed when bumped by a ball rolling on the table, said spring being in the aforementioned circuit and constituting a conductor, and *conductor means* in said circuit and embedded in the table at a point spaced from the standard and engageable by a portion of the spring when it is flexed to close the aforementioned circuit."

There are two means elements in this claim, and no fault was found with it in the majority opinion.

In *Williams Mfg. Co. v. United Shoe Mach. Corp.*, 316 U. S. 364, 86 L. Ed. 1537, 62 S. Ct. 1179, a majority in an opinion by Mr. Justice Roberts, upheld a patent for improvements in automatic heel lasting machines, affirming both the District Court and Circuit Court of Appeals. Mr. Justice Black dissented in an opinion curried in by Messrs. Justices Douglas and Murphy. The claims of the patent denounced by the dissenting justices, namely, claims 42, 55 and 84, but sustained by the majority, contained "means" clauses as follows:

Claim 42

- (1) clamping means to embrace, etc.
- (2) power operated mechanism effective to move, etc.
- (3) mechanism effective in timed relation * * * to depress, etc.
- (4) mechanism operative to actuate, etc.
- (5) manually adjustable means for * * * varying, etc.

Claim 55

- (1) clamping means to embrace, etc.
- (2) means to support a last, etc.
- (3) means to raise said support, etc.
- (4) means to operate the clamping means, etc.
- (5) mechanism operative * * * to depress, etc.
- (6) means subsequently to operate, etc.

Claim 84

- (1) the combination with last and shoe positioning means,
- (2) operating means, etc.

Numerous other examples might be cited, but the cases chosen demonstrate that "means" claims for combinations span the years since the *Paper Bag* case, and have not been forbidden. The *Williams* case, last cited, is subsequent to *General Electric Co. v. Wabash Appliance Corp.*, 304 U. S. 364, 82 L. Ed. 1402, 58 S. Ct. 899, cited by Petitioner, and continues to be applicable to combination claims. The *General Electric* case did not deal with a combination and on the facts is not parallel. We refer to it in more detail later. A study of the full text of the claims in the *Williams* case shows them to be of secondary inventions, so the use of "means" is not confined to primary inventions.

Using Gibbs claim 3 as an example, we reproduce it here with the elements of the combination verbally segregated:

Invention

Identified

A game apparatus comprising

Element (1)

a board having

Element (2)

a plurality of contact devices thereon adapted to be engaged by an object moved over the board by a player.

- Element (3)** a plurality of indicators.
- Element (4)** means for electrically connecting said indicators with a source of electric current and with said contact devices.
- Qualification and mutual relationship of Elements (2) and (3)** said indicators and said contact devices corresponding in number and arrangement and subdivided into corresponding groups.
- Element (5)** means for energizing said indicators as the associated contact devices are operated.
- Element (6)** an electrical circuit common to all of said groups and open until all of the indicators in one of said groups have been energized.
- Element (7)** and supplementary means for indicating a winning play when all of the indicators in one of said groups have been energized.

Such a claim clearly sets forth the combination of elements resulting in a new game apparatus. It is neither indefinite nor ambiguous. The specific instrumentalities selected to comply with the definitions do not constitute any crucial elements or exact points of novelty. The qualification and mutual relationship of elements (2) and (3) sets the game completely apart from the Nakashima prior patent and any of the other prior patents, and requires that the context of the whole claim be thus distinguished. Thus, element (5) must relate to energizing of indicators which correspond in number and arrangement to the contact devices and are subdivided into corresponding groups. Elements (6) and (7) also are similarly related to the groups and therefore qualified.

Petitioner erroneously predicates his case on the theory that element (5) is the exact point of novelty. He explains this by saying that Gibbs and Nakashima are the same game apparatus, except that an electrical relay in Gibbs to energize the indicators differs from Nakashima who kept his light switches closed by the weight of the balls remaining on the switches. From this he concludes that a relay in the light circuit was the only thing new with Gibbs, but that other means of keeping the circuit closed was old. Therefore, says he, "means" is too broad, and destroys the entire claim.

The whole fabric of his defense is defective. The Gibbs apparatus differs from Nakashima fundamentally. The claim defines seven interrelated elements, and produces a whole, as distinguished from its parts.

A relay in a light circuit was not *per se* new with Gibbs. It was a known instrumentality. He could not predicate invention on merely inserting a relay in a light circuit. Moreover, other devices, as weights and overbalanced switches, were known as instrumentalities for keeping a light circuit closed. The selection of the instrumentality was not critical. It supplies one of seven elements in the claim. If there is any crux of the invention apart from the whole, it resides in the qualifications of elements (2) and (3), which characterize the entire structure. Consequently, "means" is a proper term to identify an instrumentality "for energizing said indicators as the associated contact devices are operated."

By analogy, the other claims in suit also define valid combinations, and in holding all claims in suit valid the Court of Appeals followed applicable decisions of the Supreme Court.

IV.

If This Court's Decision in *Halliburton Oil Well Cementing Co. v. Walker et al.*, Supra, Is Susceptible of Being Construed to Bar "Means" Claims for a Combination of Elements Irrespective of the Position of the Invention in the Art, Such Decision Should Be Explained, Clarified or Distinguished, and the Fundamental Principles of Patent Interpretation Announced by This Court in *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U. S. 405, 52 L. Ed. 1122, 28 S. Ct. 748, Be Re-Affirmed as Controlling in Appropriate Cases.

We do not interpret this Court's decision in the *Halliburton* case as ruling out all claims for combinations in which the word "means" followed by a functional statement is employed.

However, that decision has been cited so frequently to such effect, as by Petitioner here, through the artificial selection of a "means" clause as fatally broad, indefinite, ambiguous and functional at the "exact point of novelty," that this Court would render an especial service to the interested public by express reference to the case.

One of the attorneys on Petitioner's brief, Mr. Mattingly, presented an argument on behalf of Walker in the *Halliburton* case which coincides with our exposition of patent law. Having lost that case, he joined with Mr. Fulwider in the present case to urge, as an advocate, the points which were decided against him. His true views, however, when unhampered by the duty of an attorney to his client, were recently set forth in an affidavit which he made as a friend of the Court in connection with a petition for rehearing before this Court in *Refrigeration Patents Corporation v. Stewart-Warner Corporation*, in

which affidavit he criticized the *Halliburton* decision. Inasmuch as this Court can take judicial notice of its files, we reproduce Mr. Mattingly's affidavit in an appendix to this brief.

The *Halliburton* case is one of the most widely discussed patent decisions ever handed down by the Supreme Court. Without conducting any search of current legal literature, and referring only to the Journal of the Patent Office Society, we find numerous articles and references to the decision.¹

Halliburton Oil Well Cementing Co. v. Walker, 71 USPQ 175. A Technical Knockout. By Albert M. Zalkind, of the Washington, D. C., Bar. February, 1947, Vol. XXIX, No. 2, p. 105. [All citations are to Journal of the Patent Office Society.] Mr. Zalkind refers to the case as a decision "which has cut deeply into the heart of patent rights."

Halliburton v. Walker. By Nathan A. Coun, Examiner in Div. 25 of the Patent Office. April, 1947, Vol. XXIX, No. 4, p. 289. "In the widespread discussion which has been aroused by the decision of the Supreme Court in *Halliburton v. Walker*, 593 O. G. 577, the fear has been expressed that the effect of that decision will be to make it almost impossible in many cases to draw a valid combination claim to define adequately an important improvement."

Halliburton-Hullabaloo. By George Benjamin, of New York. N. Y. April, 1947, Vol. XXIX, No. 4, p. 304. "The *Halliburton* decision of the Supreme Court, 71 USPQ 175, has provoked considerable excitement, so much, indeed, as to cause the New York Patent Law Association to make this decision the topic of a special meeting. True, the decision contains many remarks apt to worry the practitioners. Nevertheless, however, the writer thinks that much of said excitement is exaggerated or unnecessary."

No More New Combinations? By E. C. Walsh of Patent Division, U. S. Atomic Energy Commission. May, 1947, Vol. XXIX, No. 5, p. 362.

Halliburton v. Walker. By R. H. Strother, of Remington Rand, Inc. May, 1947, Vol. XXIX, No. 5, p. 375. In his closing paragraph Mr. Strother says: "I do not share Mr. Zalkind's despair. The higher courts, including the Supreme Court, have repeatedly sustained mechanical claims with a more or less wide range of equivalents."

Patent Claim Construction and the *Halliburton Oil Case*. By Carroll F. Palmer, of Washington, D. C. July, 1947, Vol. XXIX,

We precede our comments relative thereto by some preliminary thoughts.

FUNCTIONAL CLAIMS AND FUNCTIONAL CLAUSES.

Functional claims are admittedly bad as claiming an invention too broadly. But functional clauses are not necessarily so.

No. 7, pp. 515, 524. (A reprint from February, 1947, issue of *George Washington Law Review*.) —

"The Court, apparently, took the position that, since Walker added only one new element to certain old elements of the prior art, in order to bring about the 'new patentable combination,' then attention should be directed only to the new element and the patentability of this element by itself. Such reasoning seems revolutionary in view of the multitude of decisions that hold that a patentable invention may be made by combining two or more elements, all of which are old and are unpatentable if considered separately."

Halliburton Decision. By K. A. Mayr, of New York, N. Y. August, 1947, Vol. XXIX, No. 8, p. 606.

Resolution on Halliburton Doctrine. October, 1947, Vol. XXIX, No. 10, p. 768. This is a resolution by the inventors' committee of the Patent Law Association of Chicago, originally published in *Chicago Daily Law Bulletin*, Wednesday, June 25, 1947. The resolution reads in part:

"For reasons stated in the accompanying memorandum, the committee hopes that the Supreme court will, at the first opportunity, review the question of whether a claim which defines a combination embodying an inventive concept must go beyond this inventive concept to define details of a mere part of the combination."

Halliburton v. Walker. By John E. R. Hayes, of Boston, Mass. November, 1947, Vol. XXIX, No. 11, p. 842. Mr. Hayes expressed the opinion that Walker's claim was not for a true combination.

The Halliburton Oil Well Case: A Prediction. By Philip E. Siggers, Advisor to the Bureau of Patents, USAMGIC, Seoul, Korea. December, 1947, Vol. XXIX, No. 12, p. 901. His prediction is contained in the final paragraph: "In the future the pendulum will swing back again; the Supreme Court will awaken to the necessity of securing to inventors and their assigns exclusive rights as required by the Constitution * * *."

Halliburton v. Walker. By Arthur L. Jerome of the Patent Department of the Union Switch & Signal Company. January, 1948, Vol. XXX, No. 1, p. 51. This article reviews many facts

A functional claim is one which covers all means of arriving at a desired result, regardless of the machine employed. Because it can read on independent subsequent inventions of others it will not be allowed to stand.

In *O'Reilly v. Morse*, 15 How. 62, 14 L. Ed. 601, 623, Morse's claim 8 read:

"I do not propose to limit myself to the specific machinery or parts of machinery described in the

in the case not mentioned in the opinion, and justifies the holding of invalidity, on the ground that Walker's claims were "broader than his invention," but that the "decision by Justice Black includes statements which are misleading, and have been misunderstood and misinterpreted."

Halliburton-Hullabaloo Postscript. By George Benjamin of New York. February, 1948, Vol. XXX, No. 2, p. 146.

Does *Halliburton v. Walker* Make Any Innovations? By V. I. Richard. April, 1948, Vol. XXX, No. 4, p. 251. The writer there is of the opinion "that the Halliburton decision does not announce any new law * * *"

On Infringement in General and *Halliburton* Decision in Particular. By Richard Reik, of Piedmont, California. February, 1949, Vol. XXXI, No. 2, p. 112.

Halliburton v. Walker—A Symposium, Part I—General, by M. A. Crews; Part II—*Gill v. Wells* as a Precedent for the *Halliburton* Decision, by Andrew R. Klein; Part III—The Issue of Infringement in *Halliburton v. Walker*, by L. T. Phelan; Part IV—Claim Written to Satisfy Supreme Court Requirements for Walker Patent, by Joseph G. Jackson; Part V—Conclusion, by M. A. Crews, March, 1949, Vol. XXXI, No. 3, p. 176. (This was a series of papers delivered before the Philadelphia Patent Law Association February 26, 1948.) Mr. Crews believes that the Supreme Court became confused between the requirements of the statute with respect to the specification and the requirements with respect to claims, "for the court refers again and again to the inadequacy of the claim as a description of the invention, to the failure to include in the claim physical details, and to the failure of Walker to provide in his claim an explanation of the principle of his invention, and the best mode of applying it." Mr. Phelan commented, p. 193: "It is believed the Court erred in finding infringement of any of Walker's claims, and it is indeed unfortunate that the Supreme Court did not reverse upon that ground instead of holding the claims invalid for non-compliance with the statute."

"Means" at the Exact Point of Novelty. By Stuart Peterson, Assistant Examiner, Div. 60, U. S. Patent Office. March, 1949, Vol. XXXI, No. 3, p. 195.

foregoing specification and claims; the essence of my invention being the use of the motive power of the electric or galvanic current, which I call electro-magnetism, however developed for marking or printing intelligible characters, signs, or letters, at any distances, being a new application of that power of which I claim to be the first inventor or discoverer."

In holding that this claim was too broad, the court said,
14 L. Ed. 623:

"If this claim can be maintained, it matters not by what process of machinery the result is accomplished. For aught that we now know some future inventor, in the onward march of science, may discover a mode of writing or printing at a distance by means of the electric or galvanic current, without using any part of the process or combination set forth in the plaintiff's specification. His invention may be less complicated—less liable to get out of order—less expensive in construction and in the operation. But yet if it is covered by this patent the inventor could not use it, nor the public have the benefit of it without the permission of this patentee."

Numerous other examples might be cited, but would be surplusage, because it is well recognized that where a claim as a whole is functional it is objectionable.

We may next examine the rule announced by this Court outlawing functional language at "the exact point of novelty."

The claim selected as typical in *General Electric Co. v. Wabash Appliance Corp.*, *supra*, 304 U. S. 364; 58 S. Ct. 899, 82 L. Ed. 1402, (1938), was claim 25 in Patent No.

1,410,400 relating to tungsten filaments for incandescent lamps. The claim read as follows:

"25. A filament for electric incandescent lamps or other devices, composed substantially of tungsten and made up mainly of a number of comparatively large grains of such size and contour as to prevent substantial sagging and offsetting during a normal or commercially useful life for such a lamp or other device."

This Court, speaking through Mr. Justice Reed, condemned such a claim as "invalid on its face" (U. S. 368, L. Ed. 1405). The court further pointed out that in a limited field the variant must be clearly defined, and that the patent involved was one in a series of patents all dealing with filaments, and that the claim uses indeterminate adjectives which describe the function of the grains to the exclusion of *any structural* definition.

The opinion pointed out that the vice of a functional claim exists not only when a claim is wholly functional, if that is ever true, but also when the inventor is painstaking when he recites what has already been seen, and then uses "conveniently functional language at the exact point of novelty."

The court recognized (U. S. p. 371, L. Ed. p. 1407) that:

"A limited use of terms of effect or result, which accurately define the essential qualities of a product to one skilled in the art, may in some instances be permissible and even desirable. * * *"

The claim was not for a combination of elements but for a product, namely, a filament for electric incandescent lamps and made of tungsten. The "exact point of novelty," if any, presumably would have resided in the specific details of the granular construction of the tungsten wire, which details were lacking.

THE HALLIBURTON CASE.

In *Halliburton Oil Well Cementing Co. v. Walker*, *supra*, 329 U. S. 1, 91 L. Ed. 3, 67 S. Ct. 6, the claims involved were combination claims covering a Lehr and Wyatt apparatus composed of old and well-known devices to measure the time required for pressure waves to move to and back from the fluid surface of an oil well, to which Walker added a well-known device which would make the regularly appearing shoulder echo waves more prominent on the graph and easier to count. The device added was a mechanical accoustical resonator.

Claim 1 of the patent, accepted as a typical example, read as follows:

"In an apparatus for determining the location of and obstruction in a well having therein a string of assembled tubing sections interconnected with each other by coupling collars, means communicating with said well for creating a pressure impulse in said well, echo receiving means including a pressure responsive device exposed to said well for receiving pressure impulses from the well, and for measuring the lapse of time between the creation of the impulse and the arrival at said receiving means of the echo from said obstruction, and means associated with said pressure responsive device for tuning said receiving means to the frequency of echoes from the tubing collars of said tubing sections to clearly distinguish the echoes from said couplings from each other."

This Court, speaking through Mr. Justice Black, pointed out (U. S. p. 8, L. Ed. p. 9):

"But no one of the claims on which this judgment rests has even suggested the physical structure of the acoustical resonator. No one of these claims describes the physical relation of the Walker addition to the old Lehr and Wyatt machine. No one of these claims describes the manner in which the Walker addition will operate together with the old Lehr and Wyatt machine so as to make the 'new' unitary apparatus perform its designed function."

Further on the court continued (U. S. p. 8, L. Ed. p. 9):

"The language of the claim thus describes this most crucial element [the acoustical resonator] in the 'new' combination in terms of what it will do rather than in terms of its own physical characteristics or its arrangement in the new combination apparatus."

The *General Electric* and *Halliburton* cases emphasize that the violence done is in using functional language to describe the main feature of the invention. The *General Electric* case involved a "single means" claim ~~and on its~~ face. The *Halliburton* case dealt with a combination claim in an art "crowded almost, if not completely, to the point of exhaustion."

This Court stated no objection to the first three elements of the claim, two of which were "means" clauses. These first three elements described a prior art apparatus. The court held in substance that the addition of the specific form of acoustical resonator and its structural relationship with the Lehr and Wyatt apparatus was the crux of the invention, and because claimed by a "means" clause in functional form, the claim was bad.

Such law is said by this Court to be not inconsistent with the *Paper Bag* case, as pointed out by Mr. Justice Black (U. S. p. 13, L. Ed. p. 12), who stated:

"In that case [*Paper Bag* case], however, the claims structurally described the physical and operating relationship of all the crucial parts of the novel combination."

The difficulty which faces the Patent Office, patentees and the patent bar, when endeavoring to abide by the *Halliburton* case, lies in ascertaining what is an exact point of novelty or the most crucial element, in a combination.

Granting that the provisions of the statutes requiring particularity apply to combination claims, and that such claims must be definite and certain, is not that requirement fulfilled when (the claim being otherwise good) an element either known to the art or noted by the patentee to be in the form of two or more instrumentalities capable of substitution, is defined as "means" followed by a recitation of its function in relation to another element with which it co-acts?

Such an element might be the thing that creates the combination, i. e., something more than the sum of its parts, and under the *Halliburton* case could be singled out by an infringer as the exact point of novelty or the most crucial element. Yet to require the patentee to specifically name the instrumentality or specifically describe its structure and arrangement with the other elements would, in many cases, deprive him of fair protection.

Actually, the "pith" of the invention (exact point of novelty, or crucial element) in the *Paper Bag* case, if analyzed according to Petitioner's interpretation of the

Halliburton decision, was defined by the word "means" followed by a functional statement, in the following language:

"operating means for the forming plate adapted to cause said plate to oscillate about its rear edge upon the surface of the cylinder during the rotary movement of said cylinder."

That gives rise to a serious confusion. The two cases are in conflict if Petitioner's analysis is correct.

We suggest that there may be no *exact point* of novelty in a true combination, rather that the exact point of novelty is in the *concept of the combination*, and that the patent claims in the *Halliburton* case rather than having an *exact point of novelty* or a crucial element, were merely (a) broader than the invention or (b) ~~lacking in invention~~, or (c) aggregations. Those doctrines are well understood. The claims may have been broader than the invention for the reason that Walker simply adapted a particular form of resonator to the Lehr and Wyatt echo device, but broadly claimed the function of any resonator. The claims may have lacked invention for the reason that only expected skill was needed to make this adaptation. They may have defined only aggregations because the echo device and the resonator, as defined, separately performed their original functions ~~without achieving something new springing from their association~~.

A holding on any of these grounds would have protected the public against the vices charged. If the Walker invention resided in the detailed manner in which he *brought together* the old parts, as indicated in the opinion, and the art was crowded almost to the point of exhaustion, he should be relegated to his narrow claims, and his broad

claims be voided without reference to an exact point of novelty or a most crucial element, as there was none in the broad combination claims. Combination claims, which are subject to the same rigid requirements as to particularity, etc., should stand or fall on principles of law long applied.

We do not pre-~~sume~~ to criticize the result reached in the *Halliburton* case, but we respectfully suggest that the reasoning and certain language in the opinion ~~has~~ given rise to widespread uncertainty, and that a clarification could be announced which would disperse this uncertainty in the minds of Patent Office officials, inventors, manufacturers, and members of the patent bar.

The statute (R. S. 4888, 35 U. S. C. 33) requires that the ~~written description~~, i. e., the descriptive part of the specification as distinguished from the claims, to be "in such full, clear, concise, and exact terms" so that one skilled in the art may "make, construct * * * and use the same." In the case of a machine or apparatus he shall explain the principle and the best mode "in which he has contemplated applying that principle * * *."

As to the *claims*, the same statute in a clause set apart from the other by a semi-colon, directs that he "shall particularly point out and distinctly claim the * * * combination which he claims as his invention or discovery."

This clearly separates the requirements for the description and the ~~claims~~, a distinction recognized in *Merrill v. Yeomans, et al.*, 94 U. S. 568, 24 L. Ed. 235; cited in the *Halliburton* decision.

An inventive concept in a combination is fundamentally recognized by the statute, and while the descriptive part of the specification should be full and complete in detail, when it comes to the claims particularity is required only to the

extent of *pointing out and distinctly claiming the combination* asserted to be new.

As an example, two boards fastened together might constitute a combination. The fastening means could be nails, boards, screws, dowel pins or glue. To specify "nails" in a claim for the combination would deprive the patentee of a fair range of protection. To claim in combination the boards, "and means for fastening the boards together" would comply with the statute.

It appears that this Court did not distinguish in the *Halliburton* case between the description and the claims of a patent, and that the Court applied the requirements for the description, to the claims. Mr. Justice Black in the preliminary part of the *Halliburton* opinion noted that

"Petitioner's application to this Court for certiorari urged, among other grounds, that the *claims* held valid failed to make the 'full, clear, concise, and exact' *description* of the alleged invention required by Rev. Stat. §4888, 35 USCA §33, 9 FCA title 35, §33, as that statute was interpreted by us in *General Electric Co. v. Wabash Appliance Corp.*, 304 US 364, 82 L. ed 1402, 58 S. Ct 899. This statutory requirement of distinctness and certainly *in claims* is important in patent law. We granted certiorari to consider whether it was correctly applied in this case." 326 US 705, 90 L. ed 416, 66 S. Ct. 90." (Emphasis ours.)

Apparently, counsel for Halliburton by reference to the wrong part of the statute quoted by Mr. Justice Black led this Court into such a position, and having adopted it the Court then relied heavily upon the early Supreme Court decision in *Gill v. Wells*, 22 Wall. (U. S. 1), 22 L. Ed. 666, quoting therefrom to the proposition that the re-

requirement of the Patent Act directing that the invention shall be fully and exactly described, applies with as much force to a combination as to any other class of invention. Actually, the *Gill v. Wells* case was concerned primarily as to whether a reissue patent was for the same invention as the original patent, and the language from *Gill v. Wells* referred to the description and not to the claims. This Court's question for determination in *Halliburton* was set forth in the following language:

"We must, however, determine whether, as petitioner charges, the claims here held valid run afoul of Rev Stat §4888, 35 USCA §33, 9 FCA title 35, §33 because they do not *describe* the invention but use 'conveniently functional language at the exact point of novelty.' *General Electric Co. v. Wabash Appliance Corp.*, *supra* (304 US^{at} 371, 82 L ed 1407, 58 S. Ct 899)." (Emphasis ours.)

After commenting that some of the claims not in suit did describe the tuned acoustical pipe showing its structure, its working arrangement in the alleged new combination and the manner of its connection with the other parts, the Court found these things lacking in the claims in suit and concluded, "Thus the claims failed adequately to depict the structure, mode, and operation of the parts in combination."

Such language further reflects the incorrect premise for the reasoning in the opinion because the claims for a combination, while they must be definite, do not have to describe details of the structure, mode and operation of the parts except so far as may be required by the prior art, and are sufficient if in clear and certain language they define the metes and bounds of the combination, i. e., identify the several elements either by the names of

the parts or by a word such as "means" accompanied by a functional statement as to how such "means" co-acts with one or more of the other elements, so that when the whole claim is read it does not describe a specific structure or mode of operation but rather a boundary within which the detailed structure, and mode of operation explained in the description, or substituted therefor, may be comprehended.

Otherwise, the attorney will be constantly plagued by the question: When can I claim "means" and when must I specifically identify the instrumentality? And the inventor will never know whether he must apply for a plurality of patents or take his chances on a "means" claim. He will be continuously haunted by doubt as to what element in his combination a court will regard as the exact point of novelty or the most crucial element. If he or his attorney guesses wrong, he has no patent.

An illustration of this dilemma is produced by Petitioner's contention here that the element we have numbered (5) of the Gibbs claim 3 is the exact point of novelty or the crucial element. This, of course, we deny, as previously explained. The example of this element illustrated in the drawings and description includes a relay.

This relay in Gibbs' light circuit holds a switch closed by utilizing the magnetic force induced by a coil. Any weighted switch is held closed by the force of gravity pulling on the weight. Both were known to be substitutes. Gibbs could not claim both in one claim by their names, as alternatives are not allowed. He could not claim them in separate claims in the same patent as species unless he had a generic claim. A generic claim must be broad enough to include the species. What choice has a patentee, aside from a plurality of patents, except the word "means"

or a similar expression? Its use is founded on logic, and it should be preserved.

Gibbs said in his patent (R. 303, line 98):

"In the accompanying drawings I have shown a preferred form of invention, subject to modification within the scope of the appended claims without departing from the spirit thereof."

He thus contemplated possible substitutions.

His claim bars no one from inventing, patenting and using a new relay, or an improved form of weighted switch, or any other similar instrumentality, or any game apparatus which is actually different. And anyone using an improved relay in an infringing game apparatus would not be infringing because of the new relay but because the whole combination falls within the protection of the claim on the **game apparatus**. No improver of an element *per se* has ever been given the right, by virtue of his improved element, to an earlier true combination patented by another.

By the same token, no inventor of an apparatus which is a combination should be denied fair protection because someone might in the future invent an improvement in one of the parts of that combination. Fair protection must include whatever equivalents for a given part the state of the art and other circumstances will permit.

The judgment of the Court of Appeals should be affirmed.

Respectfully submitted,

HERBERT A. HUEBNER,

Attorney for Respondent.

APPENDIX.

AFFIDAVIT OF HAROLD W. MATTINGLY ACCOMPANYING
THE PETITION FOR REHEARING OF ORDER DENYING
PETITION FOR WRITS OF CERTIORARI FILED IN THE
SUPREME COURT OF THE UNITED STATES, OCTOBER
TERM, 1946, NOS. 1273 AND 1274, REFRIGERATION
PATENTS CORPORATION V. STEWART-WARNER COR-
PORATION, ETC.

State of California, County of Los Angeles—ss:

Harold W. Mattingly, being first duly sworn, deposes
and says:

That I am a member of the State Bar of California spe-
cializing in the practice of patent law in the City of Los
Angeles, State of California:

That I was the attorney for Cranford P. Walker, *et al.*
in the case of *Halliburton Oil Well-Cementing Company v.*
Cranford P. Walker, et al., 329 U. S. 1.

That immediately subsequent to the publishing of the
opinion of the Supreme Court in *Halliburton v. Walker*,
I received inquiries by letter and telephone from various
parts of the United States, namely, New York, Washing-
ton, St. Louis, Chicago, San Francisco and Los Angeles,
as to the proper interpretation to put upon the doctrine
established by that decision:

That each such inquirer expressed fear that lower courts
following said opinion literally would hold substantially
all patents to combinations of elements invalid if the ele-
ments were defined any more broadly than the one specific
embodiment set forth in the specification:

That all of the inquirers expressed their opinion that
the *Halliburton v. Walker* decision had destroyed the long

established "Doctrine of Equivalents" and the rules by which equivalency could be tested;

That affiant and none of the inquirers have been able to suggest any form of claim expression which could define an invention residing in a combination of elements in any breadth of language which does not fall within the prohibitions expressed or logically implied in the Halliburton opinion, and particularly where the elements are in themselves old in the art;

That in affiant's opinion the decision of the Court of Appeals in the 7th Circuit in the cases of *Refrigeration Patents Corporation v. Steuart-Warner Corporation* and *Potter Refrigeration Corporation v. Steuart-Warner Corporation*, 72 U. S. P. Q. 255, is typical of the manner in which Courts will interpret the *Halliburton v. Walker* decision and will feel justified in holding invalid meritorious combination patents merely because the old and well known elements used in the combination are defined in the claims in language which identifies them sufficiently to those skilled in the art but which definition may not, to the non-technical and non-scientifically trained members of the court, seem sufficient;

That in several applications now being prosecuted before the Patent Office by affiant the Examiners have rejected claims relying on the *Halliburton v. Walker* decision in support thereof and that each different Examiner has placed a different construction on the decision, creating the confusing situation that a claim would be held patentable by one division and the same claim be held unpatentable by another division.

That in affiant's opinion the Supreme Court should welcome the first opportunity to clarify, if not overrule, its

opinion in the *Halliburton v. Walker* case so that the chaotic uncertainty created by it may be cleared up for the benefit of the Courts, the Patent Bar and industry relying on clear-cut patent doctrines for the conduct of its business.

HAROLD W. MATTINGLY.

Subscribed and sworn to before me this 20th day of June, 1947.

MARJORIE MCKAY,

Notary Public in and for the County of Los Angeles,
State of California.

My Commission Expires July 15, 1949.

(Notarial Seal)